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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,929	06/22/2001	Dennis Paul Lorah	A01118a	7692
21898	7590	02/27/2004	EXAMINER	
ROHM AND HAAS COMPANY PATENT DEPARTMENT 100 INDEPENDENCE MALL WEST PHILADELPHIA, PA 19106-2399			EGWIM, KELECHI CHIDI	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 021704

Application Number: 09/887,929  
Filing Date: June 22, 2001  
Appellant(s): LORAH ET AL.

Ronald D. Bakule  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**

FEB 23 2004

**GROUP 1700**

This is in response to the appeal brief filed 12/29/2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

The rejection of claims 1-8 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). Claim 1 is representative of the invention.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5540987	MUDGE ET AL.	7-1996
5415926	LEIGHTON ET AL.	5-1995

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mudge et al. (US 5,540,987) or Leighton et al. (US 5,415,926).

Each of Mudge et al. (Abstract; col. 1, line 62 to col. 2, line 6; col. 3, lines 36-54 and col. 4, lines 38-54) and Leighton et al. (Abstract and col. 5, line 53 to col. 6, line 2) teach preparing aqueous emulsion polymers from ethylenically unsaturated monomers in the presence of redox systems comprising a t-alkyl hydroperoxide and a "non-formaldehyde-forming" reducing agents, and the products thereof, wherein Mudge et al. (col. 2, lines 3-5) and Leighton et al. (col.5, lines 65-67) each teach t-amyl hydroperoxide, a t-alkyl HP with at least 5 carbons, among a group of only three named t-alkyl hydroperoxides. This constitutes a teaching within a small group and clearly puts the invention in the possession of the public.

**(11) Response to Argument**

Regarding applicants argument that t-Bu hydroperoxide is the preferred t-alkyl hydroperoxides in the prior art references, even if, arguendo, t-amyl HP were not stated as being preferred over the other two t-alkyl hydroperoxides, it is well settled that anticipatory teachings are not limited to any particular embodiment/example. In re Boe, 148 USPQ 507 (CCPA 1966). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). The redox system comprising a 5 carbons t-alkyl hydroperoxide, t-amyl HP, is still taught by the prior art. This is clear, even if it is not exemplified. The disclosure of t-amyl HP in a very small group of only three preferred/named t-alkyl hydroperoxides is sufficient evidence of anticipation.

In response to applicant's argument that t-amyl HP shows unexpected results over t-Bu hydroperoxide, t-amyl HP is named by both cited prior art reference among a

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small group of only the preferred t-alkyl hydroperoxides. When the species is clearly named, the species claimed is anticipated no matter how many other species are additionally named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990)" Whether or not the species is disclosed as being preferred, the reference still anticipates the claim, and thus unexpected properties were immaterial." In re Sivaramakrishnan, 213 USPQ 441 (CCPA 1982) (emphasis added). (See MPEP 2131.02)

The fact that the prior art specifically names t-amyl HP among only three t-alkyl hydroperoxides is sufficient evidence that the prior art anticipated t-amyl HP as a t-alkyl hydroperoxides in the polymerization process.

For the above reasons, it is believed that the rejections should be sustained.

**KELECHI C. EGWIM PH.D.**  
**PRIMARY EXAMINER**

Respectfully submitted,

KCE 

February 18, 2004

Conferees



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